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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,687	05/31/2001	Patricia Kesling	XMS-102	8151
36183 7590 12/31/2007 PAUL, HASTINGS, JANOFSKY & WALKER LLP 875 15th Street, NW Washington, DC 20005			EXAMINER DEAN, RAYMOND S	
			ART UNIT	PAPER NUMBER
			2618	
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			12/31/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/867,687

Applicant(s)

KESLING ET AL.

Examiner

Raymond S. Dean

Art Unit

2618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-11,13-17,73 and 75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-11,13-17,73 and 75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1, 6, 11 have been considered but are moot in view of the new ground(s) of rejection.

Curtin (US 6,925,489) teaches a digital broadcast system in which identifiers associated broadcast information are downloaded from an embedded memory device to a user portable device via one of a wireless and a temporary wired connection (Col.2 lines 21 – 25, 4 lines 3 – 18, lines 54 – 67, 5 lines 1 – 2, in order for the products to be purchased there will need to be identifiers for identifying the products stored on the portable memory card, in order for the microcontroller, which contains ROM and RAM, to transfer the user-desired extracted information to the portable memory card there will need to be some handshaking that occurs between said microcontroller and said portable memory card, while said handshaking is occurring there will need to be temporary storage of said user-desired extracted information in the RAM of the microcontroller thus said RAM is acting as the embedded memory, there is also a temporary wired connection since the portable memory is removable) and wherein the identifiers are received from the user portable device (Col.2 lines 21 – 25, 4 lines 3 – 18, lines 54 – 67, 5 lines 1 – 2, in order for the products to be purchased there will need to be identifiers for identifying the products stored on the portable memory card). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the above method of Curtin in the system of Noreen in view of Merriman for the

purpose of providing flexibility to the user via enabling said user to purchase a desired product at a time that is more convenient for said user as taught by Curtin.

Claim Objections

2. Claim 6 is objected to because of the following informalities: The phrase "first quantity and the second quantity of electronic indications" should be changed to "first and second identifiers" in line 19. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 6, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants claim in Claims 1 and 6 that the electronic indications are from persons who observe the advertisements, however, Applicants later claim in Claims 1 and 6 that said the same indications are received from the user portable device. There is no clear link between the "persons who observe the advertisements" and the "user portable device".

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The disclosure does not appear to show the feature of the electronic indications being received from the user portable device or how said electronic indications are received from said user portable device. The disclosure shows that said user portable device is used to receive and transfer the identifiers referenced by said indications.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1 – 2, 4 – 11, 13 – 17, and 73, 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noreen et al. (5,303,393) in view of Merriman et al. (US 7,039,599) and in further view of Curtin (US 6,925,489)

Regarding Claim 1, Noreen teaches a method for charging advertising fees, comprising the steps of: broadcasting an advertisement for a sponsor in a broadcast

(Column 13 lines 15 – 32), wherein the broadcast includes an identifier that uniquely identifies the advertisement and at least one of the sponsor of the advertisement and a product advertised in the advertisement (Column 13 lines 15 – 32); receiving a quantity of electronic indications from persons who observe the advertisement, wherein the indications indicate interest in the product, and wherein the indications reference the identifier (Column 13 lines 33 – 67).

Noreen does not teach charging the sponsor a fee for broadcasting the advertisement, wherein the fee is based on the quantity of indications that are received, and wherein the identifier is used to calculate the fee and the identifier having been downloaded from an embedded memory device to a user portable device via one of a wireless and a temporary wired connection and wherein the identifiers are received from the user portable device.

Merriman teaches charging the sponsor a fee for broadcasting the advertisement, wherein the fee is based on the quantity of indications that are received, and wherein the identifier is used to calculate the fee (Cols. 1 lines 19 – 28, lines 35 – 43, 3 lines 5 – 11, 5 lines 46 – 50, in CPA model there will be an identifier of the advertisement thus enabling the CPA pricing or charging to occur).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the CPA model by Merriman in the system of Noreen for the purpose of generating a revenue stream as taught by Merriman.

Curtin teaches a digital broadcast system in which identifiers associated broadcast information are downloaded from an embedded memory device to a user

portable device via one of a wireless and a temporary wired connection and wherein indications are received from the user portable device (Col. 2 lines 21 – 25, 4 lines 3 – 18, lines 54 – 67, 5 lines 1 – 2, in order for the products to be purchased there will need to be identifiers for identifying the products stored on the portable memory card, in order for the microcontroller, which contains ROM and RAM, to transfer the user-desired extracted information to the portable memory card there will need to be some handshaking that occurs between said microcontroller and said portable memory card, while said handshaking is occurring there will need to be temporary storage of said user-desired extracted information in the RAM of the microcontroller thus said RAM is acting as the embedded memory, there is also a temporary wired connection since the portable memory is removable, the handshaking signals sent by said portable memory card occurs when a user indicates interest thus said handshaking signals from the portable memory card are indications).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the above method of Curtin in the system of Noreen in view of Merriman for the purpose of providing flexibility to the user via enabling said user to purchase a desired product at a time that is more convenient for said user as taught by Curtin.

Regarding Claim 2, Noreen in view of Merriman and in further view of Curtin teaches all of the claimed limitations recited in Claim 1. Noreen further teaches a time at which and a channel on which the advertisement was broadcast (Column 13 lines 23 – 27, the carrier frequency is the channel).

Regarding Claim 4, Noreen in view of Merriman and in further view of Curtin teaches all of the claimed limitations recited in Claim 1. Curtin further teaches receiving downloads of the identifiers at a central hub (Cols. 4 lines 54 – 67, 5 lines 1 – 2, 6 lines 6 – 24).

Regarding Claim 5, Noreen in view of Merriman and in further view of Curtin teaches all of the claimed limitations recited in Claim 1. Noreen further teaches broadcasting from at least one satellite (Figure 1, Column 12 lines 12 – 15).

Regarding Claim 6, Noreen teaches broadcasting a first advertisement including a first identifier; receiving a first quantity of electronic indications from persons who observe the first advertisement, wherein the first quantity of electronic indications indicate interest in the first advertisement (Column 4 lines 23 - 40, Column 13 lines 15 – 67, this is a digital broadcast radio satellite system that broadcasts multiple content nationwide to multiple subscribers thus there will be multiple identifiers and a quantity of electronic indications in response to said identifiers) and wherein the first quantity of electronic indications reference the first identifier (Column 4 lines 23 - 40, Column 13 lines 15 – 67, this is a digital broadcast radio satellite system that broadcasts multiple content nationwide to multiple subscribers thus there will be multiple identifiers and a quantity of electronic indications in response to said identifiers); broadcasting a second advertisement including a second identifier; receiving a second quantity of electronic indications from persons who observe the second advertisement, wherein the second quantity of electronic indications indicate interest in the second advertisement (Column 4 lines 23 - 40, Column 13 lines 15 – 67, this is a digital broadcast radio satellite system

that broadcasts multiple content nationwide to multiple subscribers thus there will be multiple identifiers and a quantity of electronic indications in response to said identifiers), and wherein the second quantity of electronic indications reference the second identifier (Column 4 lines 23 - 40, Column 13 lines 15 – 67, this is a digital broadcast radio satellite system that broadcasts multiple content nationwide to multiple subscribers thus there will be multiple identifiers and a quantity of electronic indications in response to said identifiers).

Noreen does not teach comparing the first quantity with the second quantity, wherein each of the first quantity of indications and the second quantity of indications references the respective first and second identifiers, charging a sponsor of at least the first advertisement a fee for broadcasting the first advertisement, wherein the fee is based on the first quantity of indications that are received, and wherein the first identifier is used to calculate the fee, and wherein the first and second identifiers having been downloaded from an embedded memory device to a portable device via one of a wireless and a temporary wired connection and wherein the first quantity and the second quantity of electronic indications are received from the portable device.

Merriman teaches comparing a first quantity with a second quantity, wherein each of the first quantity of indications and the second quantity of indications references the respective first and second identifiers (Cols. 1 lines 19 – 28, lines 35 – 43, 3 lines 5 – 11, 5 lines 46 – 50, in CPA model there will be an identifier of the advertisement thus enabling the CPA pricing or charging to occur, in order to determine if a first advertisement is outperforming a second advertisement there the results of the CPA for

said first and second advertisement will be compared), charging the sponsor a fee for broadcasting the advertisement, wherein the fee is based on the quantity of indications that are received, and wherein the identifier is used to calculate the fee (Cols. 1 lines 19 – 28, lines 35 – 43, 3 lines 5 – 11, 5 lines 46 – 50, in CPA model there will be an identifier of the advertisement thus enabling the CPA pricing or charging to occur).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the CPA model by Merriman in the system of Noreen in view of Shah-Nazaroff for the purpose of generating a revenue stream as taught by Merriman.

Curtin teaches wherein the first and second identifiers having been downloaded from an embedded memory device to a portable device via one of a wireless and a temporary wired connection and wherein the first quantity and the second quantity of electronic indications are received from the portable device (Col. 2 lines 21 – 25, 4 lines 3 – 18, lines 54 – 67, 5 lines 1 – 2, in order for the products to be purchased there will need to be identifiers for identifying the products stored on the portable memory card, in order for the microcontroller, which contains ROM and RAM, to transfer the user-desired extracted information to the portable memory card there will need to be some handshaking that occurs between said microcontroller and said portable memory card, while said handshaking is occurring there will need to be temporary storage of said user-desired extracted information in the RAM of the microcontroller thus said RAM is acting as the embedded memory, there is also a temporary wired connection since the portable memory is removable, the handshaking signals sent by said portable memory

card occurs when a user indicates interest thus said handshaking signals from the portable memory card are indications).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the above method of Curtin in the system of Noreen in view of Merriman for the purpose of providing flexibility to the user via enabling said user to purchase a desired product at a time that is more convenient for said user as taught by Curtin.

Regarding Claim 7, Noreen in view of Merriman and in further view of Curtin teaches all of the claimed limitations recited in Claim 6. Noreen further teaches wherein the first advertisement and the second advertisement are the same and wherein the step of broadcasting the first advertisement occurs at a different time of day than the step of broadcasting the second advertisement (Column 4 lines 23 - 40, this is a digital broadcast radio satellite system that broadcasts multiple content nationwide to multiple subscribers on multiple channels, the content can also be the same thus this is an inherent characteristic).

Regarding Claim 8, Noreen in view of Merriman and in further view of Curtin teaches all of the claimed limitations recited in Claim 6. Noreen further teaches wherein the first advertisement and the second advertisement are the same, and wherein the step of broadcasting the first advertisement occurs on a different channel than the step of broadcasting the second advertisement (Column 4 lines 23 - 40, this is a digital broadcast radio satellite system that broadcasts multiple content nationwide to multiple

subscribers on multiple channels, the content can also be the same thus this is an inherent characteristic).

Regarding Claim 9, Noreen in view of Merriman and in further view of Curtin teaches all of the claimed limitations recited in Claim 6. Noreen further teaches wherein the first advertisement and the second advertisement are different, wherein the first advertisement is broadcast at a particular time of day and on a certain channel, and wherein the second advertisement is broadcast at the particular time of day and on the certain channel (Column 4 lines 23 – 40, this is a digital broadcast radio satellite system that broadcasts multiple content nationwide to multiple subscribers on multiple channels thus this is an inherent characteristic).

Regarding Claim 10, Noreen in view of Merriman and in further view of Curtin teaches all of the claimed limitations recited in Claim 6. Noreen further teaches broadcasting from at least one satellite (Figure 1, Column 12 lines 12 – 15).

Regarding Claim 11, Noreen teaches a method for charging advertising fees comprising the steps of: broadcasting an advertisement of a sponsor and broadcasting a unique program identifier with the advertisement (Column 13 lines 15 – 32).

Noreen does not teach recording the unique program identifier in an embedded memory device in response to users' indicating interest in the advertisement, downloading the unique program identifier from the embedded memory device to a central hub by transferring the unique program identifier from the embedded memory device to a user portable device via one of a wireless and a temporary wired connection and employing the user portable device to effect the downloading; and charging the

sponsor a fee for each unique program identifier that is downloaded, wherein the unique program identifier is used to calculate the fee.

Merriman teaches charging the sponsor a fee for each unique program identifier that is downloaded, wherein the unique program identifier is used to calculate the fee (Cols. 1 lines 19 – 28, lines 35 – 43, 3 lines 5 – 11, 5 lines 46 – 50, in CPA model there will be an identifier of the advertisement thus enabling the CPA pricing or charging to occur).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the CPA model by Merriman in the system of Noreen¹ in view of Noreen² for the purpose of generating a revenue stream as taught by Merriman.

Curtin teaches recording the unique program identifier in an embedded memory device in response to users' indicating interest in the advertisement, downloading the unique program identifier from the embedded memory device to a central hub by transferring the unique program identifier from the embedded memory device to a user portable device via one of a wireless and a temporary wired connection and employing the user portable device to effect the downloading (Col. 2 lines 21 – 25, 4 lines 3 – 18, lines 54 – 67, 5 lines 1 – 2, 6 lines 6 – 24, in order for the products to be purchased there will need to be identifiers for identifying the products stored on the portable memory card, in order for the microcontroller, which contains ROM and RAM, to transfer the user-desired extracted information to the portable memory card there will need to be some handshaking that occurs between said microcontroller and said portable memory card, while said handshaking is occurring there will need to be temporary storage of

said user-desired extracted information in the RAM of the microcontroller thus said RAM is acting as the embedded memory, there is also a temporary wired connection since the portable memory is removable, the handshaking signals sent by said portable memory card occurs when a user indicates interest thus said handshaking signals from the portable memory card are indications).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the above method of Curtin in the system of Noreen in view of Merriman for the purpose of providing flexibility to the user via enabling said user to purchase a desired product at a time that is more convenient for said user as taught by Curtin.

Regarding Claim 13, Noreen in view of Merriman and in further view of Curtin teaches all of the claimed limitations recited in Claim 12. Curtin further teaches a personal digital assistant (Col. 4 lines 61 – 65).

Regarding Claim 14, Noreen in view of Merriman and in further view of Curtin teaches all of the claimed limitations recited in Claim 12. Curtin further teaches one of an infrared link and a radio frequency link (Col. 4 lines 61 – 65, PDAs communicate via RF links).

Regarding Claim 15, Noreen in view of Merriman and in further view of Curtin teaches all of the claimed limitations recited in Claim 11. Noreen further teaches presenting a second advertisement of a sponsor (Column 4 lines 23 - 40, Column 13 lines 15 – 67, this is a digital broadcast radio satellite system that broadcasts multiple content nationwide to multiple subscribers thus there will be multiple advertisements),

Curtin further teaches a central hub (Col. 4 lines 54 – 67, 5 lines 1 – 2, 6 lines 6 – 24), receiving click-through commands from users to activate the second advertisement (Col. 4 lines 3 – 18); launching an order screen of the second advertisement that presents a product for sale; passing the unique program identifier to the order screen (Col. 4 lines 54 – 67, 5 lines 1 – 2, 6 lines 6 – 24, the communication and downloading occur via an internet connection thus there will be URLs, the URL is the identifier); accepting an order for the product and associating the order with the unique program identifier (Col. 4 lines 54 – 67, 5 lines 1 – 2, 6 lines 6 – 24, the URL is the identifier); Merriman further teaches charging the sponsor a commission on the order (Cols. 1 lines 19 – 28, lines 35 – 43, 3 lines 5 – 11, 5 lines 46 – 50, in CPA model there will be an identifier of the advertisement thus enabling the CPA pricing or charging to occur).

Regarding Claim 16, Noreen in view of Merriman and in further view of Curtin teaches all of the claimed limitations recited in Claim 11. Noreen further teaches presenting a second advertisement of a second sponsor (Column 4 lines 23 - 40, Column 13 lines 15 – 67, this is a digital broadcast radio satellite system that broadcasts multiple content nationwide to multiple subscribers thus there will be multiple advertisements), Curtin further teaches a central hub (Col. 4 lines 54 – 67, 5 lines 1 – 2, 6 lines 6 – 24), receiving click-through commands from users to activate the second advertisement (Col. 4 lines 3 – 18); launching an order screen of the second advertisement that presents a product for sale; passing the unique program identifier to the order screen (Col. 4 lines 54 – 67, 5 lines 1 – 2, 6 lines 6 – 24, the communication and downloading occur via an internet connection thus there will be URLs, the URL is

the identifier); accepting an order for the product and associating the order with the unique program identifier (Col. 4 lines 54 – 67, 5 lines 1 – 2, 6 lines 6 – 24, the URL is the identifier); Merriman further teaches charging the sponsor a commission on the order (Cols. 1 lines 19 – 28, lines 35 – 43, 3 lines 5 – 11, 5 lines 46 – 50, in CPA model there will be an identifier of the advertisement thus enabling the CPA pricing or charging to occur).

Regarding Claim 17, Noreen in view of Merriman and in further view of Curtin teaches all of the claimed limitations recited in Claim 11. Noreen further teaches broadcasting from at least one satellite (Figure 1, Column 12 lines 12 – 15).

Regarding Claim 73, Noreen in view of Merriman and in further view of Curtin teaches all of the claimed limitations recited in Claim 1. Noreen further teaches wherein the identifier is transmitted to a broadcast receiver along with the advertisement (Column 13 lines 15 – 42).

Regarding Claim 74, Noreen in view of Merriman and in further view of Curtin teaches all of the claimed limitations recited in Claim 73. Noreen further teaches transmitting the electronic indication referencing the identifier directly from the broadcast receiver (Column 13 lines 42 – 67).

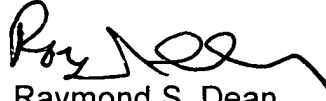
Regarding Claim 75, Noreen in view of Merriman and in further view of Curtin teaches all of the claimed limitations recited in Claim 73. Merriman further teaches transmitting the electronic indication referencing the identifier via the internet (Cols. 1 lines 19 – 28, lines 35 – 43, 3 lines 5 – 11, 4 lines 16 – 24).


Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond S. Dean whose telephone number is 571-272-7877. The examiner can normally be reached on Monday-Friday 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward F. Urban can be reached on 571-272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Raymond S. Dean
December 10, 2007


12-26-2007

NGUYEN T. VO
PRIMARY EXAMINER